

**REMARKS**

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

**I. CLAIM STATUS AND AMENDMENTS**

Claims 17-33 were pending in this application when last examined.

Claim 23 was examined on the merits and stands rejected.

Claims 17-22 and 24-33 were withdrawn as non-elected subject matter.

Claims 17-22 and 24-33 have been cancelled without prejudice or disclaimer thereto.

Applicants reserve the right to file a continuation or divisional application on any cancelled subject matter.

Claim 23 has been rewritten into an independent claim. Claim 23 has been amended to recite an “isolated” antibody and to include inherent binding properties of the claimed antibody. Support can be found in the disclosure, for example, at page 3, lines 3-4 and lines 16-21, page 5, lines 16-18 and page 6, line 21 to page 7, line 3.

New claims 34-39 have been added. Support for new claims 34-39 can also be found in the disclosure, for example, at page 3, lines 3-4 and lines 16-21, page 5, lines 16-18 and page 6, line 21 to page 7, line 3.

No new matter has been added.

Claims 23 and 34-39 are pending upon entry of this amendment.

New claims 38 and 39 are drawn to an antibody preparation process as supported by the disclosure. Furthermore, antibody preparation processes were well known in the art at the time when the present application was filed. For instance, monoclonal antibodies have been prepared since 1975 using the cell fusion technology as established by Köhler and Milstein (*Nature*, Vol. 256, pp. 495-497, 1975). Methods for producing a polyclonal antibody are also known and much older, as described in the present application on page 5, lines 16-18 and page 7, lines 19-22. In

particular, claims 38 and 39 are drawn to a process of making the antibodies (i.e., constructively elected product) of the claimed invention. It is respectfully submitted new claims 38 and 39 should be examined with the antibodies of the claimed invention, because the PTO generally permits examination of an elected product along with the method of making and/or using such product. Thus, kindly examine the process of new claims 38 and 39 along with the antibodies of the claimed invention.

In the event the Office decides to restrict out the examined product (i.e., antibody) from the process of new claims 38 and 39 and withdraw claims 38 and 39, then kindly consider the possibility of rejoining the non-elected process claims upon an indication of allowance of the elected product claims.

## **II. OBJECTION TO THE CLAIMS**

On page 1 of the Office Action, claim 23 was objected to for being dependent upon an unelected claim.

The present amendment overcomes this rejection by amending claim 23 into independent form. Thus, the claim objection is untenable and should be withdrawn.

## **III. NON-STATUTORY SUBJECT MATTER REJECTION**

On pages 2-3 of the Office Action, claim 23 was rejected under 35 U.S.C. § 101 on the basis that the claimed antibodies read on a product of nature, because the claim does not particularly point out any non-naturally occurring differences between the claimed antibodies and the naturally occurring antibodies.

The present amendment overcomes this rejection. In particular, claim 23 has been amended to recite “an isolated antibody”, and new claim 36 is also drawn to an “isolated” antibody. Accordingly, the claim no longer reads on a product of nature. Thus, the rejection is untenable and should be withdrawn.

#### **IV. WRITTEN DESCRIPTION REJECTION**

On pages 3-6 of the Office Action, claim 23 was rejected under 35 U.S.C. § 112, first paragraph, on the basis that the specification lacks written description support for the genus of antibodies that bind a polypeptide comprising SEQ ID NO: 3 and variants and fragments thereof as encompassed in the claims. The Office indicated that the specification discloses antibodies that specifically bind polypeptides consisting of SEQ ID NO: 3.

It is respectfully submitted that the present amendment overcomes this rejection as applied to the amended and new claims.

Claim 23 has been amended as suggested by the Office to delete the “variants” and “fragments thereof” language. Furthermore, the claim has been amended along the lines indicated as supported by the Office to read “an antibody that specifically binds to a polypeptide consisting of the amino acid sequence of SEQ ID NO: 3.” Support can be found in the disclosure, for example, at page 3, lines 3-4 and lines 16-21, page 5, lines 16-18 and page 6, line 21 to page 7, line 3.

Therefore, the rejection of claim 23 under 35 U.S.C. § 112, first paragraph, is untenable and should be withdrawn.

#### **V. ANTICIPATION REJECTION**

On pages 6-7 of the Office Action, claim 23 was rejected under 35 U.S.C. § 102(b) as anticipated by Korneluk et al. (WO 97/26331) (hereinafter “Korneluk”).

This rejection is respectfully traversed as applied to the amended claims.

To anticipate a claim, a cited prior art reference must teach each and every element of the claimed invention. M.P.E.P. § 2131.01.

Claim 23 has been amended to distinguish the antibodies of the present invention from those described by Korneluk. In particular, the amended claims call for an isolated antibody that

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specifically binds to a polypeptide consisting of the amino acid sequence of SEQ ID NO: 3 but not to a polypeptide consisting of the amino acid sequence of SEQ ID NO: 1. Korneluk fails to disclose or suggest this binding property of the claimed antibody. Thus, Korneluk fails to teach each and every element of the claimed invention. Thus, Korneluk does not anticipate the claimed invention.

Therefore, the rejection of claim 23 under 35 U.S.C. § 102(b) is untenable and should be withdrawn.

### CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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